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EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/353,625

Applicant(s)  
Ekker et al.

Examiner  
Nga B. Nguyen

Art Unit  
3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/4/03 and 2/12/03
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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### **DETAILED ACTION**

1. This Office Action is the answer to the Request for Continuing Examination (RCE) filed on February 12, 2003 and the Amendment filed on February 4, 2003, which paper has been placed of record in the file.
2. Claims 29, 30 are added. Claims 1-30 are pending in this application.

#### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new grounds of rejection.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 11-24 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The claims, as presently claimed and best understood were reconsidered in light of the "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

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The claimed invention merely manipulate an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Moreover, mere recitation in the preamble or mere suggestion in the claim that a machine is performing some or all of the steps in the method is not enough to place claimed invention in the technological arts. Tho body of the claims must unambiguously recite that a machine/apparatus is performing the steps and/or is integrally involved in the process.

The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is not a product for performing a process, not it is a specific machine or manufacture. The claimed invention is not a specific tangible machine for facilitating a business transaction. Claims 11-24 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompassed any product of the class configured in any manner to perform the underlying process. The claimed invention of claims 11-24 also does not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 11-24 are analyzed based upon the underlying process, and are thus rejected as being directed to a non-

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statutory process. Therefore, the claims are non-statutory, because they are directed solely to an abstract idea without practical application in the technological arts.

***Claim Rejections - 35 USC § 112***

6 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7 Claims 1-10, 25, 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-10, 25, 26 recite "a system" in the preamble, but contain no means or structure in the body of the claims.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-20 and 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Block et al (hereinafter Block), U.S. Patent No. 6,377,938.

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Regarding to claim 1, Block discloses a system comprising:

a continuously running event creation process determining whether a system initiated and created event is due to be created (column 6, lines 37-40, Tariff Memory 76, system initiated and created flat rate charge, taxes, etc...); and

a continuously running pricing process pricing the system-created events an non-system-created events as they become available to the system (column 7, lines 55-column 8, lines 6, processor 60 performs real time billing calculation for system-created events e.g., flat charges, monthly equipment rental fees, etc..., and non-system-created events:, e.g., call charges).

Regarding to claim 2, Block further discloses all events are priced as they become available to the system (column 7, lines 55-column 8, lines 6).

Regarding to claim 3, Block further discloses all system-created events are created at any time based on a flexible schedule independent of a billing process (column 8, lines 1-3, flat charges, monthly equipment rental fees).

Regarding to claim 4, Block further discloses system initiated and created events for a customer may be created one of less frequently than the customer is billed, as frequently as the customer is billed and more frequently than the customer is billed (column 8, lines 1-3, flat charges, monthly equipment rental fees are initiated and created as frequently as the customer is billed).

Regarding to claim 5, Block further discloses summary events are created and maintain in real-time as events are priced (column 9, lines 15-32).

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Regarding to claim 6, Block further discloses all events are available for contribution to summary records for discounting and consolidation (column 7, lines 43-50).

Regarding to claim 7, Block further discloses charges for all events that are relevant to a billing period are calculated and available in the system at the earliest practical time (column 9, lines 27-32).

Regarding to claim 8, Block further discloses processing for calculating charges to be billed in a current billing period is outside the billing process (column 7, lines 55-63).

Regarding to claim 9, Block further discloses charges for all unbilled events are ready for the billing process and ready for display on-demand (column 9, lines 15-32).

Regarding to claim 10, Block further discloses pricing process performs real-time recalculation of a charge for any unbilled event when information in the system which impact the charge has changed (column 7, lines 43-50).

Regarding to claim 11, Block discloses a process, comprising:  
determining whether a system initiated and created event is priceable (column 6, lines 37-40, Tariff Memory 76, system initiated and created flat rate charge, taxes, etc...); and  
pricing the event responsive to the determining (column 7, lines 55-column 8, lines 6, processor 60 performs real time billing calculation for system-created events e.g., flat charges, monthly equipment rental fees, etc..., and non-system-created events:, e.g., call charges).

Regarding to claim 12, Block further discloses priceable events are price immediately (column 7, lines 55-63).

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Regarding to claim 13, Block further discloses all charge events are price in real-time (column 6, lines 23-25).

Regarding to claim 14, Block discloses a process, comprising:  
determining whether an event is priceable (column 7, lines 55-63); and  
pricing the event responsive to the determining, wherein all available charge events for a current billing period are priced at a first opportunity after a prior billing period ends (column 15-32).

Regarding to claim 15, Block further discloses a usage event is price at a time that the usage occurs (column 7, lines 55-63).

Regarding to claim 16, Block further discloses a recurring charge is calculated after an end of a prior billing period and before the billing date for the recurring charge (column 8, lines 1-3).

Regarding to claim 17, Block further discloses a minimum or a maximum charge is calculated and captured in a summary after and end of a prior billing period and before the billing date for the recurring charge (column 7, lines 5-15).

Regarding to claim 18, Block further discloses charges for summary events are calculated on-demand at a time of charge display (column 9, lines 15-32).

Regarding to claim 19, Block discloses a process, comprising:  
determining whether a system initiated and created event is due to be created (column 6, lines 37-40, Tariff Memory 76, system initiated and created flat rate charge, taxes, etc...); and



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creating the event responsive to the determining (column 8, lines 1-3, flat charges, monthly equipment rental fees).

Regarding to claim 20, Block further discloses system initiated and created events are created independent of other processes (column 8, lines 1-3, flat charges or monthly equipment rental fees are created independent of the process of calculating a call charge).

Regarding to claim 23, Block further discloses a recurring event is created after an end of a prior billing period and before the billing date for the recurring charge (column 8, lines 1-3, flat charges, monthly equipment rental fees).

Regarding to claim 24, Block further discloses minimum and maximum charge summary events are created after an end of a prior billing period and before the billing date for the recurring charge (column 7, lines 5-15).

Regarding to claim 25, Block discloses a system, comprising:

a continuously running event creation process determining whether a system initiated and created event has become current (column 6, lines 37-40, Tariff Memory 76, system initiated and created flat rate charge, taxes, etc...); and

a continuously running pricing process pricing the system-recreated events and on-system-created event as the become available to the system, and creating and maintaining summary events in real-time as events are priced (column 7, lines 55-column 8, lines 6, processor 60 performs real time billing calculation for system-created events e.g., flat charges, monthly equipment rental fees, etc..., and non-system-created events:, e.g., call charges).

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Regarding to claim 26, Block discloses a system, comprising:

a continuously running event creation process determining whether a system initiated and created event is due to be created and creating system-created events at any time base on a flexible schedule (column 6, lines 37-40, Tariff Memory 76, system initiated and created flat rate charge, taxes, etc...); and

a continuously running pricing process, independent of a billing process, pricing of the system-created and non-system-created events as ready for the billing process and for display as they become available to the system with all events priced as they become available to the system and creating summary events as events are being priced and performing real-time recalculation of a charge for any unbilled event when information in the system which impacts charge has changed (column 7, lines 55-column 8, lines 6, processor 60 performs real time billing calculation for system-created events e.g., flat charges, monthly equipment rental fees, etc..., and non-system-created events:, e.g., call charges; column 9, lines 15-32, creating the bill based on demand of the subscriber; column 7, lines 43-50, recalculation a charge based on the discounts).

Regarding to claim 27, Block discloses an apparatus, comprising:

a source of system initiate and created events (column 6, lines 27-45, The network Routing Device 30); and

a processor pricing the events when the events are priceable (column 6, lines 2-26, Processor 60).

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Claim 28 is written in computer medium that parallel the limitations found in claim 1 discussed above, therefore is rejected by the same rationale.

10. Claims 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Griffin U.S. Patent No. 5,893,077.

Regarding to claim 29, Griffin discloses a system providing pricing information for on-demand billing for events, comprising:

a message queue (column 17, lines 37-41 and figures 8A, item 350, 8B, item 351); and  
a processor performing a pricing process where events are continuously delivered to the pricing process via the message queue (column 6, lines 42-65, the billing server 108 performs a pricing process by gather events from the event collector 102 which is gather the events from the message queue).

Regarding to claim 30, Griffin discloses a continuous pricing process for an event-driven system, comprising:

storing events in a message queue, the events being one of system created events, usage events, one time events, or summary events (column 17, lines 37-41; figures 8A, item 350, 8B, item 351 and column 13, lines 44-60);

delivering the events in the message queue to a pricing process (column 6, lines 42-65, the events in the message queue are delivered to the event collector 102, and then to the billing server 108 for pricing); and

pricing the events (column 13, line 60-column 14, line 21).

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***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Block et al (hereinafter Block), U.S. Patent No. 6,377,938 in view of Jagadish et al (hereinafter Jagadish), U.S. Patent No. 6,058,170.

Regarding to claims 21, 22, Block does not disclose system initiated and created events are created according to a schedule in the system and the schedule is created and maintained by the system based on subscription information available in the system. However, Jagadish discloses system initiated and created events are created according to a schedule in the system and the schedule is created and maintained by the system based on subscription information available in the system (column 4, lines 10-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the feature above with Block's for the purpose of initiating and creating events based on the schedule in the system.

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*Conclusion*

13. Claims **1-30** are rejected.

14. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Jagadish et al. (US 6,125,173) discloses a method and system of telephone call processing that provides information to customers while telephone calls are made.

Jagadish et al. (US 6,173,046) discloses a method and system in which calls made by customers who are members of a group of customers having a group calling plan.

Cameron et al. (US 6,317,490) discloses method and apparatus for real-time billing account query.

Grimes (US 6,434,537) discloses a telephone billing management method for cellular telephones.

Baulier et al. (US 6,496,831) discloses a real-time event processing system for processing a sequence of events generated by one or more applications.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703)306-2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703)308-0505.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.

**16. Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

**or faxed to:**

(703) 305-7687, (for formal communications intended for entry)


**or:**

(703) 308-3961 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen  
April 3, 2003

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600